

### REMARKS

Initially, Applicants have amended claims 196, 242, 271-273, 280-287, 289-290, and 292 to more accurately claim the present invention and not for any reason related to patentability. No new matter has been added. Applicants believe that the following comments overcome the rejections set forth in the March 3, 2003 Office Action and that the rejections should be withdrawn.

#### 10 I. THE INVENTION

Generally, the present invention is a system for accessing electronic data via a familiar printed medium. Specifically, the familiar printed medium is a printed real estate listing. Also, the machine recognizable feature may be one of various embodiments including, but not limited to, a watermark, bar code, invisible bar code, magnetic code, printed character, invisible icon, etc. When a machine recognizable feature is recognized, an electronic signal is transmitted for processing. The processing results in the display of programming material related to the information contained in the printed real estate listing. Importantly, the present invention is designed to allow a user to access programming material related to the information contained in the printed real estate listing to

supplement the information provided by the printed real estate listing.

## II. THE EXAMINER'S REJECTIONS

5       The Examiner rejected claims 168-170, 287, and 290 under 35 U.S.C. § 102(b) as being anticipated by Withnall et al. U.S. Patent No. 4,488,035 (hereinafter referred to as "Withnall") in view of Ruppert et al. U.S. Patent No. 5,424,524 (hereinafter referred to "Ruppert"). Because  
10 this rejection was listed in the section entitled "Claim Rejections - 35 U.S.C. § 103" and the rejection cites more than one reference, Applicants believe that the Examiner meant to issue this rejection under 35 U.S.C. § 103(a) like subsequent rejections.

15       Initially, the Examiner argued that Withnall discloses a transport system having a microprocessor-based, optical ticket reader that reads information from a printed ticket to determine and display the validity of the ticket. Also, the Examiner explained that a microprocessor-based ticket  
20 printer is used to issue bar-coded tickets. The Examiner then indicated that reference information is stored in memory which communicates with the ticket-checking means.

However, the Examiner admitted that Withnall fails to disclose bar codes for encoding real estate information,

which the Examiner contended was obvious. The Examiner argued that such a feature would be "a possible application of the system as taught by [Withnall]" and was also "old" and a "design consideration." (March 3, 2003 Office Action  
5 Summary, p. 5). For support, the Examiner cited Ruppert for disclosing a "scanner/computer" for scanning barcodes for assistance in shopping for real estate. According to the Examiner, Ruppert allows shoppers to scan bar codes appearing on signs at real estate properties in order to  
10 access information in the corresponding real estate listing.

Next, the Examiner rejected claims 172-196, 288, and 291 under 35 U.S.C. § 103(a) as being unpatentable over Withnall "in view of the general teachings of the prior art  
15 of record." (March 3, 2003 Office Action Summary, p. 6). The Examiner admitted that Withnall fails to disclose a data link that carries certain types of data and video images, which the Examiner believed to be obvious. For evidence, the Examiner cited Thacher *et al.* U.S. Patent No.  
20 5,083,271 (hereinafter referred to as "Thacher"), Ertz *et al.* U.S. Patent No. 5,003,577 (hereinafter referred to as "Ertz"), and Plummer U.S. Patent No. 4,992,824 (hereinafter referred to as "Plummer"). Thacher and Ertz were cited for describing various data links. Also, Plummer was cited for

disclosing data links that transmit image and video information.

Additionally, the Examiner rejected claims 197-221, 289, and 292 under 35 U.S.C. § 103(a) as being unpatentable  
5 over Withnall "in view of the general teachings of the prior art of record." (March 3, 2003 Office Action Summary, p. 7). The Examiner admitted that Withnall fails to disclose watermarks, invisible bar codes, magnetic codes, printed characters, and invisible icons. The Examiner took  
10 Official Notice that the use of these features as a data input source was known. For support, the Examiner cited Konishi et al. U.S. Patent No. 5,237,156 (hereinafter referred to as "Konishi") and Younger U.S. Patent No. 5,151,687 (hereinafter referred to as "Younger"). The  
15 Examiner cited Konishi for disclosing a scanner for bar codes, magnetic characters, and character recognition. Younger was cited for acknowledging several types of "media-taped" materials.

Subsequently, the Examiner rejected claims 222-255  
20 under 35 U.S.C. § 103(a) as being unpatentable over Withnall and common knowledge in the art. The Examiner admitted that Withnall differed from the claims for not encoding various information in machine recognizable indicia, which the Examiner asserted to be obvious. The

Examiner also noted that "a Court has decided that printed matter such as encoding particular information in a code, etc., would not be given patentable weight (In re Gulack, 217, U.S.P.Q. 401)." (March 3, 2003 Office Action Summary, p. 8).

Also, the Examiner rejected claims 256-270 under 35 U.S.C. § 103(a) as being unpatentable over Withnall in view of Ishii et al. U.S. Patent No. 5,148,297 (hereinafter referred to as "Ishii"). The Examiner admitted that Withnall does not disclose certain claimed display devices. The Examiner then took Official Notice that the use of certain display devices was known. As evidence, Ishii is disclosed for providing a liquid crystal display ("LCD").

Next, the Examiner rejected claims 271-286 under 35 U.S.C. § 103(a) as being unpatentable over Withnall and common knowledge in the art. Although the Examiner admitted that Withnall fails to disclose certain code recognition devices, the Examiner took Official Notice that the use of such devices was old.

### **III. THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN**

The Examiner rejected claims 222-255 under 35 U.S.C. § 103(a) as being unpatentable over Withnall and common knowledge in the art. Also, the Examiner rejected claims

271-286 under 35 U.S.C. § 103(a) as being unpatentable over Withnall and common knowledge in the art. Applicants respectfully disagree with both of these rejections. Specifically, Withnall does not disclose the programming material of the claimed invention. The programming material of the present invention is designed such that it can be easily altered or updated at any time. As a result, a user will be provided with the most recently updated version of the associated information (or programming material) upon scanning a printed real estate listing. Withnall, on the other hand, scans a commuter ticket to ascertain a validity state associated with that ticket. However, at no point does Withnall provide more substantial programming material which includes various supplemental information corresponding to the printed real estate listing. Regardless of whether any of the features indicated by the Examiner are obvious, Withnall still fails to disclose the unobvious programming material of the present invention, and therefore, these rejected claims cannot be unpatentable over Withnall and common knowledge in the art.

Also, the Examiner rejected claims 168-170, 287, and 290 under 35 U.S.C. § 103(a) as being unpatentable over Withnall in view of Ruppert. Next, the Examiner rejected

claims 172-196, 288, and 291 under 35 U.S.C. § 103(a) as being unpatentable over Withnall in view of Thacher, Ertz, and Plummer. Additionally, the Examiner rejected claims 197-221, 289, and 292 under 35 U.S.C. § 103(a) as being unpatentable over Withnall in view of Konishi and Younger. Also, the Examiner rejected claims 256-270 under 35 U.S.C. § 103(a) as being unpatentable over Withnall in view of Ishii.

Applicants respectfully disagree and submit that none of the aforementioned claims are obvious in view of the references cited against them. In order for a claimed invention to be obvious in view of a combination of references, three criteria must be met: 1) there must exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all of the claim limitations. (see *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)) (see also Manual of Patent Examining Procedure §§ 2143-2143.03).

Initially, Applicants submit that no suggestion or motivation exists to modify or combine Withnall with any of the aforementioned references.

"Standing on their own, these references provide no justification for the combination asserted by the Examiner. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (Emphasis in original).

The Examiner contended that it would have been obvious to combine the teachings of Withnall with the aforementioned references to arrive at the various embodiments of Applicants' invention. Yet, the Examiner has not pointed to what motivation is provided by the references themselves. Applicants submit that no combination of these references would have been obvious to one of skill in the art at the time of Applicants' invention, especially because no motivation or suggestion for combining these references exists within the references themselves. Specifically, Withnall discloses a system for easing the examination of commuter tickets for validity. This has no connection with Ruppert, which discloses a scanner/computer for providing storing and displaying shopping lists. Withnall has no apparent connection to Thacher which discloses a scoring system for video game tournaments. Withnall also has no clear connection with



Ertz's interface between a video terminal and a voicemail system. Additionally, Withnall does not relate in any way to Plummer's system for printing on a photosensitive film via an LCD. Moreover, Withnall lacks relation to Konishi's apparatus for reading index information from images for expediting image registration. In addition, Withnall does not show any relation to Younger, which discloses an apparatus that logs information pertinent to "media-taped" material. Finally, there is no relation between Withnall and Ishii, which discloses an LCD that provides better image quality when viewed at an angle. The differing purposes of these references have no overlap in use, and therefore, would not provide one skilled in the art with a motivation or suggestion to combine these references. Thus, an inventive step must be performed for one skilled in the art to arrive at the idea of combining any features of Withnall, with any features of the aforementioned references.

Upon reconsideration, the Examiner will undoubtedly recognize that the reasons put forth for the § 103(a) rejection actually support an "obvious to try" argument. Of course, "obvious to try is not the standard for obviousness under 35 U.S.C. § 103." Hybritech, Inc. v.

Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 91 (Fed. Cir. 1986).

Under these circumstances, Applicants respectfully submit that the Examiner has succumbed to the "strong  
5 temptation to rely on hindsight." Orthopedic Equipment Co. v. United States, 702 F. 2d 1005, 1012, 217, U.S.P.Q. 193, 199 (Fed. Cir. 1983):

10 "It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in  
15 a court of law."

Applicants submit that the only suggestion or motivation for the Examiner's combination of references is provided by the teachings of Applicants' disclosure. No such suggestion or motivation is provided by the references  
20 themselves; nor could there be in view of the difference in subject matter and the corresponding goals thereof.

In view of the foregoing, base claims 168, 287, and 290 cannot be unpatentable over any combination of Withnall and the aforementioned references. The remaining rejected  
25 claims are dependent on these claims and contain all of the limitations of their respective base claims. Therefore, these dependent claims are also not unpatentable over these references.

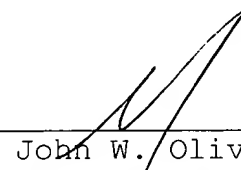


CONCLUSION

Applicants submit that all pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. Early and  
5 favorable action is accordingly solicited.

Respectfully submitted,

Date: 6-3-2003

  
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JUN -6 2003  
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